

REMARKS

This responds to the Office Action dated June 19, 2006, and the references cited therewith.

Claim 59 is amended, no claims are canceled or added; as a result, claims 34-66 are now pending in this application.

§112 Rejection of the Claims

Claim 59 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant has amended claim 59 to more clearly recite the subject matter. No new matter is added.

Reconsideration and allowance of claim 59 are respectfully requested.

§102 Rejection of the Claims

Claims 34-37 and 62-64 were rejected under 35 U.S.C. § 102(b) as being anticipated by Scott (U.S. Patent No. 5,005,587).

Applicant respectfully traverses the rejections of claims 34-37 and 62-64, for at least the following reasons. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Moreover, “For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be *identically* shown in a single reference.” (Emphasis added). *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990). Applicant respectfully submits the rejections of claims 34-37 and 62-64 fail because all of the elements are not identically shown in the cited reference. Applicant cannot find, for example, an outer coating of composite insulative material coated directly on at least one conductor, as recited in claim 34. Claims 35-37 and 62-64 depend from claim 34 and thereby include all of its limitations.

Further, Applicant respectfully submits that Scott fails to identically show in as complete detail, for example, an outer coating of composite insulative material coated directly on at least one conductor, as recited in claim 34, and incorporated in claims 35-37. According to M.P.E.P. § 2131, “the identical invention must be shown in the cited reference in as complete detail as is

contained in the claim.” *See also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1988). The Office Action states at page 2, last paragraph to page 3, first paragraph, “Scott teaches a braid conductor (Figure 2) 43 that has a composite coating (layer 54 and layer 56 deposited on top[]).” Applicant respectfully traverses this statement in so far as it fails to properly characterize the teaching of Scott. Instead, Scott recites at column 5, lines 19-32, “A polyurethane outer tube 54 is placed over braid 42 and positioned so that its distal end is adjacent to the proximal end of the Silastic ® tube 38, with braid 42 passing between the adjacent ends of outer tube 54 and tube 38. A molded sleeve 56 formed of polyurethane is placed over the transition region . . . Sleeve 56 is secured with Dow Corning medical adhesive which is applied to its inner surface prior to placement on catheter 10.” In contrast, claim 34 recites, an outer coating of composite insulative material coated directly on at least one conductor. Applicant respectfully submits that the tubes 54, 38 and sleeve 56 of Scott fail to identically show in as complete detail an outer coating of composite insulative material coated directly on a conductor, as recited in claim 34 and incorporated in claims 35-37 and 62-64.

Moreover, Applicant respectfully traverses the Office Action statement at page 3, last paragraph, “Applicant does not particularly point out what the examiner is missing from the claim under the 102 rejection.” As described above, Scott fails to identically show in as complete detail an outer coating of composite insulative material coated directly on a conductor, as recited in claim 34. Applicant respectfully requests the next Office Action explains how the tubes 54, 38 and sleeve 56 of Scott identically show, pursuant to MPEP § 2131, the outer coating of composite insulative material coated directly on a conductor, as recited in claim 34, or withdraw this line of argument. Absent such a showing, it appears that the Office Action relies on personal knowledge in making such an assertion. Pursuant to 37 C.F.R. § 1.104(d)(2), Applicant traversed the assertion in the Office Action Response filed December 22, 2005, traverses the assertion here again, and respectfully requests the Examiner submit an affidavit providing support for the assertion with the next Office Communication or withdraw this line of argument.

Additionally, Applicant traverses the Office Action statement at page 3, first partial paragraph, “The product by process claims provide no distinguishable structure.” Applicant is unclear which claims the Office Action refers to. Claims 34-37 and 62-64 recite a lead

assembly, and Applicant respectfully submits claims 34-37 and 62-64 are not limited to product by process claims.

Reconsideration and allowance of claims 34-37 and 62-64 are respectfully requested.

§103 Rejection of the Claims

Claims 34-37, 47-51 and 65-66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush et al. (U.S. Patent No. 5,674,272) in view of Scott (U.S. Patent No. 5,005,587).

I. Scott and Bush Alone Or In Combination Fail to Teach Each Element of the Claims.

Applicant respectfully traverses the rejections of claims 34-37, 47-51 and 65-66 for at least the following reasons. Applicant can not find in the cited references teaching or suggestion of, for example, an outer coating of composite insulative material coated directly on at least one conductor, as recited in claim 34. Claims 35-37 depend from claim 34 and thereby include all of its limitations. Further, Applicant can not find in the cited references teaching or suggestion of, coating a first composite insulative material between at least the first conductor and the second conductor, and coating a second composite insulative material on at least an outer surface of the second conductor, as recited in claim 47. Claims 48-51 and 65-66 depend from claim 47 and thereby include all of its limitations.

Further, Applicant respectfully traverses the Office Action statement at page 3, first full paragraph, “Bush teaches a multilayer member as shown in figure 7 including a first conductor 114 and a second conductor with composite layers between the conductors as well as forming an outer layer.” Applicant submits claim 34, for example, recites an outer coating of composite insulative material coated directly on at least one conductor. Moreover, Applicant submits claim 47 recites coating a first composite insulative material between at least the first conductor and the second conductor, and coating a second composite insulative material on at least an outer surface of the second conductor. The cited references fail to teach or suggest all of the elements of the claims, as described above. For example, Bush states at column 6, lines 50-55, “An inner electrical conductor 102 is tubularly and coaxially covered with an inner layer of tubing 104 . . . An intermediate coaxially oriented tubular layer 106, such as silicone rubber, covers inner

ePTFE layer 104." Moreover, Scott states at column 5, lines 19-32, "A polyurethane outer tube 54 is placed over braid 42 and positioned so that its distal end is adjacent to the proximal end of the Silastic ® tube 38, with braid 42 passing between the adjacent ends of outer tube 54 and tube 38. A molded sleeve 56 formed of polyurethane is placed over the transition region . . . Sleeve 56 is secured with Dow Corning medical adhesive which is applied to its inner surface prior to placement on catheter 10." Applicant respectfully submits the Office Action appears to equate a "layer of tubing" or "tube" with the outer coating of composite insulative material coated directly on at least one conductor, as recited in claim 34. Further, Applicant respectfully submits the Office Action appears to equate placing a "layer of tubing" or "tube" with coating a first composite insulative material between at least the first conductor and the second conductor, and coating a second composite insulative material on at least an outer surface of the second conductor, as recited in claim 47. However, the Office Action fails to support such an assertion with any teaching or suggestion from the cited references that supports equating such structure with the elements of claims 34 and 47.

Absent such teaching or suggestion for the missing elements, as described above, it appears that the Office Action takes Official Notice of the missing elements. Pursuant to MPEP § 2144.03, "If applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the Examiner *must* support the finding with adequate evidence. The Examiner *must* provide documentary evidence in the next Office Action if the rejection is to be maintained." (Emphasis added). Applicant respectfully submits there appears to be no evidence in the record to support the taking of Official Notice of, for example, the outer coating of composite insulative material coated directly on at least one conductor, as recited in claim 34. Further, there appears to be no evidence in the record for coating a first composite insulative material between at least the first conductor and the second conductor, and coating a second composite insulative material on at least an outer surface of the second conductor, as recited in claim 47. Applicant traversed such Official Notice in the Response dated December 22, 2005, traverses the Official Notice here again, and requests a reference showing the missing elements. Absent such a showing, pursuant to 37 C.F.R. § 1.104(d)(2), Applicant submits the assertions are within the personal knowledge of the Examiner and requests an affidavit in support of the assertions or withdrawal of this line of argument.

Because Bush and Scott alone or in combination fail to teach each and every element of the claims, the Office Action fails to provide a proper *prima facie* case of obviousness.

II. The Office Action Fails to Maintain a Prima Facie Case of Obviousness Because Combining and Modifying Bush and Scott in the Proposed Manner Would Impermissibly Change the Principle of Operation of Bush and Scott.

The rejections of claims 34-37, 47-51 and 65-66 fail to maintain a *prima facie* case of obviousness because, among other reasons, combining and modifying Bush with Scott in the proposed manner would change the principle of operation of Bush and Scott. According to *In re Ratti*, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959); MPEP § 2143.01. Applicant respectfully submits Bush states at column 6, lines 50-55, “An inner electrical conductor 102 is tubularly and coaxially covered with an inner layer of tubing 104 . . . An intermediate coaxially oriented tubular layer 106, such as silicone rubber, covers inner ePTFE layer 104.” Moreover, Scott states at column 5, lines 19-32, “A polyurethane outer tube 54 is placed over braid 42 and positioned so that its distal end is adjacent to the proximal end of the Silastic ® tube 38, with braid 42 passing between the adjacent ends of outer tube 54 and tube 38. A molded sleeve 56 formed of polyurethane is placed over the transition region . . . Sleeve 56 is secured with Dow Corning medical adhesive which is applied to its inner surface prior to placement on catheter 10.” As previously described above, claims 37 and 47 recite an entirely different method for applying insulation that neither Bush nor Scott appear to teach or suggest. For example, claim 34 recites an outer coating of composite insulative material coated directly on at least one conductor. Claim 47 recites coating a first composite insulative material between at least the first conductor and the second conductor, and coating a second composite insulative material on at least an outer surface of the second conductor. Applicant respectfully submits that exchanging the tubes of Bush and Scott with coatings of composite insulative material as described in claims 34 and 47, and incorporated in claims 35-37, 48-51 and 65-66, would impermissibly change the principles of operation of both Bush and Scott. Because the principles of operation of Bush and Scott would be changed with such a modification, the

proposed combination is thereby insufficient to render claims 34-37, 47-51 and 65-66 *prima facie* obvious.

III. The Office Action Fails to Provide a Properly Supported Motivation to Combine and Modify Bush with Scott in the Proposed Manner.

Further, Applicant respectfully submits the Office Action fails to provide a legally sufficient motivation to combine and modify the references in the manner proposed. Pursuant to MPEP § 2143.01, “[t]he mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (Emphasis in the original). *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Additionally, *In re Fine* states, “the rational to modify or combine the prior art . . . may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles or legal precedent.” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); MPEP §2144. However, the Office Action fails to provide any suggestion from the cited prior art for combining Bush and Scott in the proposed manner. Moreover, Applicant respectfully submits the Office Action Statement at page 3, first full paragraph, “Using a braid conductor for that of a coil would have been an obvious choice to those of ordinary skill in the art with Scott showing such a construction,” is merely a conclusory statement that fails to provide any reasoning to support a suggestion to combine Bush and Scott in the proposed manner. Further still, Applicant respectfully submits the Office Action fails to provide any suggestion from the cited prior art or reasoning to support modifying Bush and Scott to use coatings of composite insulative material as described in claims 34 and 47. As previously discussed above, Bush and Scott both appear to describe the use of tubes as opposed to the structure and steps recited in claims 34 and 47. Applicant respectfully requests the next office communication provide a legally sufficient motivation to combine and modify Bush and Scott in the manner proposed or withdraw this line of argument.

Moreover, Applicant respectfully traverses the Office Action statement at page 3, last paragraph, “[I]n terms of the 103 rejection, the examiner disagrees with applicant’s characterization of the references.” Applicant respectfully submits that the Office Action Response of December 22, 2005 did not characterize the references. Instead, Applicant recited

quotations from the cited references that supported Applicant's positions. Moreover, Applicant respectfully requests the next Office Communication provide support for the Office Action statement at page 3, last paragraph, "it was well known to substitute braids for coils." Without such support, Applicant submits the statement is conclusory and requests withdrawal of this line of argument.

Absent such a showing, Applicant can only assume the Office Action attempts to use the Applicant's disclosure as a template and perform improper hindsight reconstruction. Pursuant to *In re Gorman*, the Examiner can not use the Applicant's disclosure as a "template" and simply select or modify elements from the references to reconstruct the claimed invention. *In re Gorman*, 933 F.2d 982, 987, (Fed. Cir. 1991). Because the Office Action fails to provide a *prima facie* case of obviousness that supports the proposed combination and modification of Bush and Scott, Applicant respectfully submits the Office Action simply picks and chooses elements from the cited references and then modifies them, as previously described, to meet each of the recitations of claims 34-37, 47-51 and 65-66.

Reconsideration and allowance of claims 34-37, 47-51 and 65-66 are respectfully requested.

Allowable Subject Matter

Applicant graciously acknowledges the allowance of claims 38-39, 52-57, 58 and 60-61.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. However, should the Examiner not find the claims in such a condition, the Examiner is invited to telephone Applicant's attorney at (612) 371-2117 to facilitate prosecution of this application.

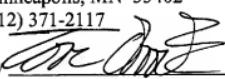
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

JON SCHELL

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 371-2117

By 
Thomas C. Obermark
Reg. No. 55,506

Date 10/20/06

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioners of Patents, P.O. Box A450, Alexandria, VA 22313-1450 on this 29 day of October 2006.

Marta Scully
Name

Patricia J. Scully
Signature